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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,063	12/30/2003	Spencer W. Beaufore	OPMI / 07	7404
26875	7590	09/06/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP			STIGELL, THEODORE J	
2700 CAREW TOWER			ART UNIT	
441 VINE STREET			PAPER NUMBER	
CINCINNATI, OH 45202			3763	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/749,063

Applicant(s)

BEAUFORT ET AL.

Examiner

Theodore J. Stigell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 76-86 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56-64 is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-27, 33-50, 53-55 and 65-75 is/are rejected.
- 7) ☒ Claim(s) 11-13, 28-32, 51 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/12/04, 4/13/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 6/23/2006 is acknowledged. The traversal is on the ground(s) that a search for either the apparatus or the method would likely encompass a search for both. This is not found persuasive because the method is extremely broad and can be performed by many different structures and would therefore require a search in many different classes and subclasses that would not be required for the apparatus.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-10, 14-24, 26-27, 33-36, 38-44, 46-50, 53-55, and 65-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Doyle (6,290,206). Doyle discloses an adaptor (4) that can be used with a urinary catheter having a normally closed valve, the adaptor comprising a fluid tube (10) to sealingly engage the discharge end of the catheter and an internal diameter sized for fluid flow therethrough, and a member (14) associated with the fluid tube and having an external dimension sized to allow fluid to flow around, the member adapted to engage the closed valve and keep the valve open while the fluid tube is sealingly engaged with the discharge end, wherein the

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discharge end is tubular, further comprising a releasable clip (76) adapted to pinch and secure the fluid tube to the discharge end, wherein the member is a solid rod-shaped member, and further comprising a protuberance (12) positioned to butt up against a portion of the urinary catheter when the member engages the downstream side of the valve thereby preventing the member from being further inserted into the valve, wherein the protuberance is located on the releasable clip, wherein the member is sized to pass through the valve (20) and extends beyond the fluid tube.

Claims 1-6, 8-10, 14, 16-23, 25-27, 33-35, 37-43, 45-50, 53-55, and 65-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Mathieu (4,745,950). Mathieu discloses an adaptor (6) that can be used with a urinary catheter having a normally closed valve (58), the adaptor comprising a fluid tube (21) to sealingly engage the discharge end of the catheter and an internal diameter sized for fluid flow therethrough, and a member (28) associated with the fluid tube and having an external dimension sized to allow fluid to flow around, the member adapted to engage the closed valve and keep the valve open while the fluid tube is sealingly engaged with the discharge end, wherein the discharge end is tubular, further comprising a releasable clip (46) adapted to pinch and secure the fluid tube to the discharge end, wherein the member is a hollow, rod-shaped member, and further comprising a protuberance (44) positioned to butt up against a portion of the urinary catheter when the member engages the downstream side of the valve thereby preventing the member from being further inserted into the valve, wherein the protuberance is located on the releasable clip, wherein the member is sized to pass through the valve (58) and extends beyond the fluid tube.

***Allowable Subject Matter***

Claims 11-13, 28-32, 51-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 56-64 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Stigell whose telephone number is 571-272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Theodore J. Stigell

  
**NICHOLAS D. LUCCHESI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**